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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/494,837 01/31/00 MATHEW

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EXAMINER

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AFTERGUT, J

ART UNIT

PAPER NUMBER

1733

DATE MAILED:

05/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/494,837

Applicant(s)

MATHEW ET AL.

Examiner

Jeff H. Aftergut

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8,9,14 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) 1,8,9,14 and 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 8, 9, 14, 18-21, drawn to a method of making a hose, classified in class 156, subclass 149.
 - II. Claims 22-26, drawn to a hose, classified in class 138, subclass 123.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be manufactured by another and materially different process such as one which included the step of coating toe glass fibers prior to braiding about the extruded tube with a fluorocarbon dispersion whereby the braid was provided with a coating on both its inner and exterior surfaces.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Amy Rinaldo on 5-15-01 a provisional election was made with traverse to prosecute the invention of Group II, claim 22-26. Affirmation of this

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election must be made by applicant in replying to this Office action. Claims 1, 8, 9, 14, 18-21 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 22-26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over E.P. 439898.

At the outset, it should be pointed out that applicant's earliest afforded effective filing date for claim 22 is 2-23-93 (in Serial Number 08/023,417 the applicant first introduced the use of two dispersions wherein one applied a first dispersion to the tubing, braided over the same,

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and then applied a final dispersion over the same). E.P. '898 was printed 8-7-91 (more than a year before applicant's afforded effective filing date) and therefore the reference is available under 35 USC 102(b). The reference to E.P. '898 taught that one skilled in the art would have provided a hose with a braided glass fiber thereon. Prior to application of the glass fiber onto the tubing, the reference suggested that one skilled in the art would have applied a fluoropolymeric dispersion onto the glass fibers employed in the braid. By performed this step, the finished tubing was provided with a dispersion 20 which completely coated and embedded the glass fiber braid 18 disposed about the extruded tubing 16. While the claims at hand recite two separate dispersion coating operation (one on the tubing followed by braiding and then an additional coating upon the braid) there is no reason to believe that the product produced by this process would have been any different from the product made by E.P. '898. It should be noted that the applicant has the burden to show that the processing as claimed would have produced a materially different product. The Office is not able to produce products by the myriad of processes placed before it and make physical comparisons between the so produced products. While it is believed that the product of '898 anticipates the claimed invention, applicant is advised that the gist of the disclosed invention therein was to ensure that the braided fibers were completely embedded within the polymeric dispersion applied to the same and that the polymeric dispersion not only coated the exterior of the braid but made contact with the extruded hose as well, see column 1, line 50-column 2, line 2. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide additional coatings as deemed necessary in order to make sure that the braid was completely immersed within the fluoropolymer using the techniques of E.P. 439898.

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With regard to claims 23 and 24, note that the dispersion employed in E.P. '898 was a fluoropolymeric dispersion and thus the product produced would have had the braid embedded within the fluoropolymer. Regarding claim 25, the reference suggested that surfactants would have been included within the dispersion, see column 4, lines 29-30. Regarding claim 26, the dispersion was cured (see for example column 7, lines 12-14). It is not clear whether the inclusion of a curing agent would have produced a materially different finished product or not. Additionally, the use of a curing agent in a fluoropolymer dispersion is taken as conventional in the art.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of claims 23 and 24, the applicant recites that the dispersion is selected from the group consisting of "fluorocarbon polymer...", however the independent claim (claim 22) recited that the dispersion comprised a fluorocarbon polymer. How can the dispersions be anything by fluorocarbon polymer as defined in claim 22? It is suggested that in claim 22 the applicant remove from the claim that a fluorocarbon polymer was used as the dispersion for the first and second coatings in order to make claims 23 and 24 consistent with the independent claim.

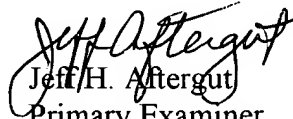
Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. E.P. 380841 related to formation of a fluoropolymer hose with a braided layer thereon which included a Teflon dispersion therein. The references to Green '476, Martucci '782, and Morin et al all related to fluoropolymer tubes with braided fibers thereon as well as a dispersion of fluoropolymer coating the same.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 703-308-2069. The examiner can normally be reached on Monday-Friday 6:30-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3599 for regular communications and 703-305-7718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Jeff H. Aftergut
Primary Examiner
Art Unit 1733

JHA
May 17, 2001